

REMARKS

Applicants note that all amendments and cancellations of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG), and without waiving the right to prosecute the amended or cancelled Claims (or similar Claims) in the future.

The Examiner has rejected Claims 1 and 5-10 under 35 USC §103 as allegedly being obvious in light of Shanahan et al., US Patent Publication 2005/0022114 (hereinafter Shanahan) in view of Sragner (U.S. Patent 6,272,485; hereinafter Sragner). The Applicants respectfully disagree. In response to Applicants' arguments that Shanahan does not teach or suggest that contextual markups are images that are added as invisible images that map to the image file, the Examiner states "it is noted that the features upon which applicant relies (i.e., "invisible image layers") are not recited in the rejected claim(s)." (Office Action, pg. 8). The Applicants respectfully disagree and direct the Examiner to Claim 1, lines 10-11 and Claim 7, lines 17-18, which describe invisible image layers.

Nonetheless, for business purposes and to further the prosecution of the present application, while reserving the right to prosecute the original or similar claims in the future, the Applicants have amended Claims 1 and 7 to clearly articulate that the markups are contained in invisible image files that map exactly onto each image of each page of the image document. Support for these amendments can be found, for example, on page 11, lines 4-12 of the specification. The Applicants submit that neither Shanahan nor Sragner, alone or in combination, teach invisible image files containing contextual markups that map exactly onto each image of each page of the image document, without marking the image document.

Accordingly, the Applicants submit that the Examiner has not demonstrated a prima facie case of non-obviousness because neither Shanahan nor Sragner, alone or in combination, teach or suggest every element of the claimed invention. As such, the rejection under U.S.C. 103 is improper and the rejection should be withdrawn.

The Examiner further rejects Claims 14 and 15 under 35 U.S.C. 103 as allegedly obvious in light of Shanahan in view of Sragner and further in view of Banerjee et al. (U.S. Patent Application 2004/0205130; hereinafter Banerjee). The Applicants respectfully disagree. As

described above, Shanahan in view of Sragner does not teach or suggest the claim element of invisible image files containing contextual markups that map exactly onto each image of each page of the image document, without marking the image document. Nor does Banerjee teach this element. As such, the Applicants submit that the Examiner has not demonstrated a prima facie case of non-obviousness because neither Shanahan, Sragner nor Banerjee, alone or in combination, teach or suggest every element of the claimed invention. As such, the rejection under U.S.C. 103 is improper and the rejection should be withdrawn.

CONCLUSION

All grounds of rejection of the Office Action of April 15, 2009 have been addressed and reconsideration of the application is respectfully requested. It is respectfully submitted that the claims should be allowed. Should the Examiner have any questions, or if a telephone conference would aid in the prosecution of the present application, Applicants encourage the Examiner to call the undersigned collect at 608-218-6900.

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